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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,903	12/08/2004	Catharina Svanborg	bjs-4984-4	7669
23117 7590 02/06/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
HOBBS, LISA JOE				
ART UNIT		PAPER NUMBER		
1657				
MAIL DATE		DELIVERY MODE		
02/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/506,903

**Applicant(s)**

SVANBORG ET AL.

**Examiner**

Lisa J. Hobbs

**Art Unit**

1657

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10-14, 19-21, 23, 24, 27-34 and 36-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14, 19-21, 23, 24, 27-34 and 36-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20 Dec 2006, 11 Nov 2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement(s) (IDS) submitted on 20 December 2006 and 11 November 2008 is/are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement(s) is/are being considered by the examiner.

### ***Drawings***

The previous objection to the specification because the panels of the drawings did not match the Brief Description of the Drawings is withdrawn in light of the amendment to the specification submitted 20 December 2006. The drawings are acceptable as filed 07 September 2004.

### ***Status of Claims***

Claims 1-8, 11-14, 19-21, 23, 24, 27-34, and 36-53 are pending and under consideration. Claims 9, 10, 15-18, 22, 25, 26, and 35 have been cancelled. No claims are withdrawn as being drawn to a non-elected invention. The amendment of 11 November has added new claims 37-53, depending from newly independent claim 2.

***Claim Objections***

Claims 3, 23-24, 27-28, 37, 50-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 1-8, 11-14, 19-21, 23, 24, and 27-28 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of the amendments to claim 1.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-8, 11-14, 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants amended claims 1 and 5 to refer to a cofactor that is “C16 to C18” in length and “with at least one double bond in the cis configuration”; these particular statements constitute new matter. The specification discloses structures of sizes C16, C18, and C20, with one to four double bonds in cis configuration, for example at Figure 1 and on pages 3, 18, and 24, but no additional information is provided regarding structures with other sizes, such as C17 or C19 and those with more than four double bond in cis configuration. The specific language grouping molecules of “C16 to C18” in size, excluding the C20 exemplifications and including C17 size molecules, which are not exemplified or discussed, but excluding presumed C19 species as well is not described or supported by the specification as filed. There is no statement in the specification or the original claims describing this particular size grouping or how this grouping would be beneficial or desired as opposed to any other disclosed species. Though a genus of fatty acids is claimed with the general language of the original claims, fatty acids with “similar configuration”, there is no disclosure of a specific group of “C16 to C18” size molecules.

As well, there is no disclosure in the specification that a grouping of any number of double bonds is envisioned or would be functional in the instant invention. Figure 1 and pages 3, 18, and 24 of the specification discuss fatty acids with cis, as opposed to trans, conformation being desirable, but nowhere is language stating that the grouping of “at least one double bond in the cis configuration”, which could encompass six double bonds or the entire chain of molecules with double bonds is envisioned. Fatty acids with four and five double bonds were known by those of skill in the art, as discussed in applicant's response from 11 November 2008, but the specification provides no information on the reaction of a molecule with “at least one”, double

bond. The specific language reciting that the cofactor can comprise "at least one", i.e., any, number of double bonds was not disclosed or supported in the specification or original claims. As previously discussed, a recitation of a genus of cofactors that stabilize the complex or have a "similar configuration" does not provide description sufficient to support language claiming specific groupings of molecules.

Claims 2 and 38-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2 and 39 to refer to a cofactor that is "C16 to C18" in length; this phrase constitutes new matter. The specification discloses structures of sizes C16, C18, and C20, with one to four double bonds in cis configuration, for example at Figure 1 and on pages 3, 18, and 24, but no additional information is provided regarding structures with other sizes, such as C17 or C19 and those with more than four double bond in cis configuration. The specific language grouping molecules of "C16 to C18" in size, excluding the C20 exemplifications and including C17 size molecules, which are not exemplified or discussed, but excluding presumed C19 species as well is not described or supported by the specification as filed. There is no statement in the specification or the original claims describing this particular size grouping or how this grouping would be beneficial or desired as opposed to any other disclosed species. Though a genus of fatty acids is claimed with the general language of the original claims, fatty acids with

“similar configuration”, there is no disclosure of a specific group of “C16 to C18” size molecules.

***Conclusion***

Claims 29-34 and 36 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa J. Hobbs whose telephone number is 571-272-3373. The examiner can normally be reached on Hotelling - Generally, 9-6 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Jon P. Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lisa J. Hobbs/  
Primary Examiner  
Art Unit 1657